

**Request for Withdrawal of Final Office Action**

Applicants respectfully request that the Examiner reconsider the Final Office Action and withdraw the Final Office Action as premature (*See* MPEP706.07(d)).

**BACKGROUND**

During a telephonic interview after final rejection, the Examiner raised, for the first time (from applicants' perspective), the argument that the element contained in the last two lines of applicants' Claim 1 was inherently contained in the Preast and Gibney references (Interview Summary of the Examiner and also of Applicants' Attorney). Gibney and Preast had been cited as references by the Examiner as anticipating applicants' Claim 1. The word "inherent," as well as its derivatives, do not appear in the First Office Action or in the Final Office Action in regard to the Gibney and Preast references.

The First Office Action did not address the final element of applicants' claim 1 disclosed in the last two lines of applicants' claim 1, which includes: "said at least one predetermined distance has a relationship to at least one game parameter." The "at least one predetermined distance" referred to is disclosed earlier in claim 1 in the language: "at least one icon is located at least one predetermined distance axially along the pool cue shaft from the ferrule-receiving portion of said pool cue shaft." In the First Office Action, the rejection under 35 U.S.C. 102(b) of Claim 1, as allegedly anticipated by Gibney, does not address the final element of claim 1. Applicants timely raised this issue in applicants' AFFIRMATION OF ELECTION AND OFFICE ACTION RESPONSE page 6. In the First Office Action, the rejection under 35 U.S.C. 102(b) of Claim 1, as allegedly anticipated by Preast, does not address the final element of claim 1. Applicants timely raised this issue in applicants' AFFIRMATION OF ELECTION AND OFFICE ACTION RESPONSE page 7.

In the Final Office Action, the Examiner made a bare assertion that "Gibney's icons 14 are located a predetermined distance along the shaft and this distance, as is all the icon marking, is related to aiming the cue. This is all that is required by the claims." The phrase "aiming the cue" does not appear in the claims. In the Final Office Action, the

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Examiner made a bare assertion that “Preast’s colored laminates may be considered icons and are located a predetermined distance along the shaft and this distance, as is all of the icon marking, may be used to aim the cue. This is all that is required by the claims.” The phrase “aim the cue” does not appear in the claims.

#### RULES and LAW

Applicant is entitled to request that the Final Rejection be withdrawn. MPEP 706.07(d), *Final Rejection, Withdrawal of, Premature* provides, in relevant part that: “If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.” The Examiner had an obligation to be expressly clear in making an inherency argument in the First Office Action and the Final Office Action. MPEP 707.07(d), *Language To Be Used in Rejecting Claims*, provides in relevant part that: “Where a claim is refused for any reason relating to the merits thereof it should be “rejected” and the ground of rejection fully and clearly stated,” (emphasis added); MPEP 707.07(g), *Piecemeal Examination*, provides, in relevant part, that “Where a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression.” 37 C.F.R. 1.104(c)(2) provides, in pertinent part, that: “The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.”

An inherency argument requires a showing that the undisclosed element necessarily results from the reference, not merely that the undisclosed element is possible or probable. MPEP 2112(IV) provides in relevant part: “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic”; *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. (emphasis added); *In re*

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*Robinson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999) (probability and possibility are not sufficient to establish inherency); *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) ("In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." (emphasis in original); *Scaltech Inc. v. Retec/Tetra, L.L.C.*, 156 F.3d 1193, 48 USPQ2d 1037 (Fed. Cir. 1998), *revised and reissued*, 178 F.3d 1378, 1384, 51 USPQ2d 1055, 1059 (Fed. Cir. 1999) (as revised subsequent to *Pfaff* (1999) ("Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency."); *Munising Paper Co. v. American Sulphite Pulp Co.*, 228 F. 700, 703-03 (6<sup>th</sup> Cir. 1915) ("[A]nticipation is not disclosed by a drawing which incidentally shows a similar arrangement of parts, where such arrangement is not essential to the first invention and was not designed, adapted, and used to perform the function which it performs in the second invention, and where the first patent contains no suggestion of the way in which the result sought is accomplished by the second invention."); *James River Corp. of Virginia v. Hallmark Cards, Inc.*, 915 F. Supp 968, 1000 (E.D. Wis. 1996) ("the on sale bar does not apply to accidental, unintended, and unappreciated sales or uses."); *Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364, 1373, 62 USPQ2d 1865 (Fed. Cir. 2002) ("anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must *necessarily* include the unstated limitation...").

#### ARGUMENT

Applicants respectfully submit that it is incorrect procedure for the Examiner to raise an argument for the first time after issuing a final rejection. Such an error in procedure denies applicants the opportunity to respond to the rejection in a first office action. Where the Examiner never mentioned anticipation by inherency in either the First Office Action or in the Final Office Action, and where an inherency argument was not apparent from the language used by the Examiner, applicants are denied their right to a full and fair discussion of the merits of their application. The arguments presented by the Examiner regarding Preast and Gibney are not clearly identified as inherency arguments

Request for Withdrawal of Final Office Action and, in the Alternative, Response to Final Office Action in the First and Final Office Actions. The word “inherent” does not occur in the office action in regard to Gibney and Preast (although it does appear in regard to Williams and Holt) and the crucial element of a prima facie case of inherency (necessity) is not presented in either office action or in the Examiner’s Interview Summary. To make a prima facie case of anticipation by inherency, the Examiner must show that the missing descriptive matter is necessarily present in the thing described in the reference. (MPEP 2112(IV); *In re Robinson*, *supra*; *Ex parte Levy*, *supra*; *In re Oelrich*, *supra*; *Scaltech Inc. v. Retec/Tetra, L.L.C.*, *supra*; *James River Corp. of Virginia v. Hallmark Cards, Inc.*, *supra*; *Transclean Corp. v. Bridgewood Services, Inc.*, *supra*). If the Examiner intended those arguments to be regarded as inherency arguments, the grounds should have been “fully and clearly stated” MPEP 707.07(d)) and “clearly explained” (37 C.F.R.

1.104(c)(2)). In the Interview Summary provided by the Examiner, the Examiner states that “the marks of Gibney and Preast were capable of being used as claimed and therefore inherently met the limitations as to icon limitations” (emphasis added). “Capable” speaks to possibility or probability, not necessity. (MPEP 2112(IV); *In re Robinson*, *supra*; *Ex parte Levy*, *supra*; *In re Oelrich*, *supra*; *Scaltech Inc. v. Retec/Tetra, L.L.C.*, *supra*; *James River Corp. of Virginia v. Hallmark Cards, Inc.*, *supra*; *Transclean Corp. v. Bridgewood Services, Inc.*, *supra*). Accordingly, applicants respectfully submit that the Examiner has not presented a prima facie case of anticipation by inherency.

Furthermore, applicants respectfully submit that the arguments presented by the Examiner regarding Preast and Gibney are not impliedly inherency arguments, as no prima facie case of inherency argument may be based upon Preast or on Gibney. For a prima facie case of inherency to lie, the Examiner must show that the allegedly inherent element is necessarily contained in the reference (MPEP 2112(IV); *In re Robinson*, *supra*; *Ex parte Levy*, *supra*; *In re Oelrich*, *supra*; *Scaltech Inc. v. Retec/Tetra, L.L.C.*, *supra*; *James River Corp. of Virginia v. Hallmark Cards, Inc.*, *supra*; *Transclean Corp. v. Bridgewood Services, Inc.*, *supra*). Not only has no such showing been made in either Office Action or in the Interview Summary, applicants respectfully submit that no such showing is possible.

The Examiner has argued that the different colors of wood in the disclosure of Preast form icons that anticipate applicants’ claim 1 (OA, page 4, FOA page 3, Interview

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Summary of Examiner). The allegedly inherent element is disclosed in the last two lines of applicants' claim 1: "said at least one predetermined distance has a relationship to at least one game parameter." However, different colors of wood are not necessary for the invention of Preast, but only preferred, (Preast, Col. 1, lines 10-11). Preast does not claim differently colored woods, further indicating that differently colored woods are not necessary to Preast's invention. In a patent directed to "an improved construction of pool or billiard cue" (Preast, Col. 1, lines 8-9) Preast discloses using different colored woods to "present a pleasing appearance" (Preast, Col 2, lines 86-87) while describing one particular embodiment of the invention. Applicants respectfully submit that, where the alleged icons of Preast do not necessarily exist, the predetermined distance between such unnecessary (and sometimes non-existent) icons and the ferrule-receiving portion of the shaft cannot necessarily have a relationship to a game parameter. Accordingly, there was no reason for applicants to believe that the Examiner's arguments in the First Office Action and in the Final Office Action were based on inherency.

The drawing of Preast (FIG. 1) incidentally shows an arrangement of marks along the shaft of the pool cue, which is not essential to Preast's invention and was not disclosed as being designed, adapted, and used to perform the function which it performs in applicants' claim 1 (*Munising Paper Co. v. American Sulphite Pulp Co.*, *supra*). Furthermore, Preast contains no suggestion of the way in which applicants' result sought is accomplished. *Ibid*. Even in the case where woods of different colors are used by Preast, the positioning of Preast's alleged icons is the result of the interaction of the thickness of the laminae and the taper of the cue shaft (Preast, Col. 1, lines 42-48). Preast never relates the positioning of the alleged icons to any game parameter or to any other use than the production of a pleasing appearance (Preast, Col. 1, line 15; Col. 2, line 87). Therefore, no prima facie case of anticipation by inherency may be based upon FIG. 1 in Preast. Accordingly, there was no reason for applicants to believe that the Examiner's arguments in the First Office Action and in the Final Office Action were based on inherency. Therefore, no response by applicants to an inherency argument based on Preast would have been appropriate after the First Office Action.

The Examiner has argued (Interview Summary) that the icons in the disclosure of Gibney inherently anticipate the last element of applicants' claim 1. However, the pre-

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determined distance between the ferrule-receiving portion of the cue shaft and the alleged icons of Gibney does not necessarily relate to a game parameter (MPEP 2112(IV); *In re Robinson, supra*; *Ex parte Levy, supra*; *In re Oelrich, supra*; *Scaltech Inc. v. Retec/Tetra, L.L.C., supra*; *James River Corp. of Virginia v. Hallmark Cards, Inc., supra*; *Transclean Corp. v. Bridgewood Services, Inc., supra*). Gibney discloses that the distance between the ferrule and the icon, if any, is related to visibility of the alleged icon (Gibney, Page 2, ¶1, ¶3). Indeed, Gibney discloses that there may be no predetermined distance at all between the ferrule-receiving portion of the pool cue shaft and the icon where he discloses “a small visible part close to the cue tip, conveniently just below any ferrule for the tip itself but feasibly also on or extending onto such ferrule” (Gibney, page 2, lines 14-16, emphasis added). When the alleged icon extends onto the ferrule, there is no icon “located at least one predetermined distance axially along the pool cue shaft from the ferrule-receiving portion of said pool cue shaft” (Claim 1). Where a predetermined distance between the ferrule and the icon does not necessarily exist, the relationship between Gibney’s optional predetermined distance and a game parameter cannot be necessary to Gibney’s invention. Therefore, no prima facie case of anticipation by inherency can lie based on Gibney. Accordingly, there was no reason for applicants to believe that the Examiner’s arguments in the First Office Action and in the Final Office Action were based on inherency. Therefore, no response by applicants to an inherency argument based on Gibney would have been appropriate after the First Office Action.

Accordingly, applicants respectfully submit that the finality of the rejections based upon Preast and Gibney are premature, as they have been made based upon arguments of which applicants had no notice in the First Office Action or the Final Office Action. Applicants’ respectfully request that the Final Office Action be withdrawn as premature.

In the alternative, applicants respectfully submit that the inherency argument was waived by not being timely presented. Because the inherency argument is essential to the rejection of the claims (admitting, by its existence, that there is no express anticipation of applicants’ claims) applicants respectfully request the Examiner to see that a prima facie case of anticipation does not lie. Accordingly, the Examiner should allow applicants’ claims.

**Response to Final Office Action**

If the Examiner elects to withdraw the Final Office Action in its entirety, then the following response is informational only and need not be entered. If the Examiner does not elect to withdraw the Final Office Action in its entirety, then applicants respectfully submit the following pages as a Response to Final Office Action in furtherance of moving the application to allowance or appeal.